

AUG 25 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Applicants:

Ali Afzali-Ardakani et al.

Serial No.: 10/057,024

Filed: January 25, 2002

For: SYNTHESIS OF SOLUBLE DERIVATIVES OF SEXITHIOPHENE AND THEIR USE AS
THE SEMICONDUCTING CHANNELS IN THIN-FILM FIELD-EFFECT TRANSISTORS

Date: August 25, 2004

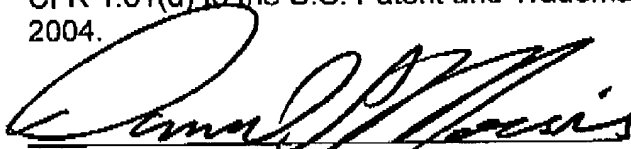
Group Art Unit: 1626

Examiner: D. C. Lambkin

Docket No.: YOR920000442US2

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**CERTIFICATE OF FACSIMILE TRANSMISSION**

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Dr. Daniel P. Morris, Esq.
Reg. No. 32,053

APPEAL TO THE BOARD OF APPEALS AND INTERFERENCES

Sir:

Patent holder Applicant hereby appeals, Pursuant to 37 C.F.R. 1.192(c), the Examiner's final rejection of Claims 1-10 and 19-20 as set forth in the: Final Office Action dated February 10, 2003.

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REAL PARTY IN INTEREST

The above-identified patent has been assigned to the International Business Machines Corporation. The assignment has been recorded in the U.S. Patent and Trademark Office: Recordation date July 12, 2000; Reel/Frame 010965/0309.

RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

STATUS OF CLAIMS

Claim 1-10 and 19-20 have been rejected.

STATUS OF AMENDMENTS

On May 5, 2004, subsequent to the final rejection Applicants filed a timely response after final rejection dated February 16, 2004, which did not amend the claims and which was entered by Advisory Action dated June 21, 2004. Applicants filed a timely notice of Appeal on May 5, 2004. On July 8, 2004 a Second Response After Final Rejection has been submitted, to which no Advisory Action has been received as of the filing of this Appeal.

SUMMARY OF THE INVENTION

A broad aspect of the present invention are soluble derivatives of sexithiophene in which terminal carbons are substituted with various polar groups such as phosphonic esters, phosphonic acids, phosphonates, carboxylic acids, carboxylates, amines, amides, carbamates, and alcohols, each separated from the terminal thiophene rings by one or more methylene groups, are synthesized.

ISSUES

1) Are claims 1-10 and 19-20 not patentable under 35 USC 101 for double patenting over US Patent No. 6,414,164?

GROUPING OF THE CLAIMS

Each claims is appealed separately.

ARGUMENTS

Claims 1-10 and 19-20 have been rejected under 35 USC 101 for double patenting over prior US Patent No. 6,414,164. Applicants respectfully disagree. No claims under examination in the present application is identical to the claims of US 6,414,164 and thus a double patenting rejection of the non-obvious type is improper. A terminal disclaimer over US 6,414,164 has been provided which overcomes a double patenting rejection of the obviousness type. The claims presented herein are generic to the claims of US 6,414,164.

Since the claims of the present invention are not drawn to the "same invention", that is identical subject matter, a double patenting rejection is not proper under *In re Vogel* 164 USPQ 619.

In comment 10 of the Advisory Action dated 6-21-04, the Examiner states "claim 1 is incomplete, please provide definition for R." R is defined to be a "polar functionality" in claim 1. Thus, there is no formal rejection based on this comment.

In view of the above, it is clear that the Examiner erred in the final rejection of claims 1-10 and 19-20. Accordingly, it is respectfully requested that the Board reverse the Examiner.

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Respectfully submitted,

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